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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,211	06/25/2001	Guy A. Story	80293/33	2684

20277 7590 06/03/2009

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EXAMINER	
STRANGE, AARON N	

ART UNIT	PAPER NUMBER
2448	

MAIL DATE	DELIVERY MODE
06/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/892,211	STORY ET AL.	
	Examiner	Art Unit	
	AARON STRANGE	2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-70 and 72-102* is/are pending in the application.

4a) Of the above claim(s) *32-39,65-69 and 72-102* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *40-64 and 70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action. The Examiner feels that an interview would help foster a mutual understanding of the respective positions of Applicant and the Examiner, and assist in the identification of allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

Election/Restrictions

2. Applicant's election without traverse of claims 40-64 and 70 in the reply filed on 3/26/09 is acknowledged.

Response to Arguments

3. Applicant's arguments with respect to claims 40-64 and 70 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 40-64 and 70 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,253,237. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-26 of U.S. Patent No. 6,253,237 contain every element of claims 40-64 and 70 of the instant application and thus anticipate the claims of the instant application. Claims 40-64 and 70 are therefore not patentably distinct from the earlier patent claims and as such are unpatentable over obviousness-type double patenting. A later patent claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

The Examiner believes that the relationship between claims 40-64 and 70 and claims 1-26 of U.S. Patent No. 6,253,237 is apparent from a simple reading of the claims. Therefore, in the interest of brevity, a mapping between the claims has not been provided here.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 46-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. With regard to claims 46-51, independent claim 46 is directed to an “apparatus” comprising a plurality of “means for” performing various functions. Claim 52 is directed to "sequences of instructions" for performing the same functions. The claimed "means" are not limited to hardware by the specification or the claim, and Applicant claims the same functions as being performed by “sequences of instruction”, the claimed means are directed to at least some software-only embodiments. Since the claims are not limited to statutory subject matter, they are non statutory.

9. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 40-57, 60-62 and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters et al. (US 5,440,334).

12. With regard to claim 40, Walters discloses a method of providing personalized time-shifted media programming, comprising:

retrieving multiple titles of digital media content from one or more libraries (library contains multiple titles of digital media in off-line storage(col. 8, ll. 54-57);
storing the multiple titles of media content for subsequent playback (some of the files are stored in storage unit 240 in the library)(col. 8, ll. 21-36); and

storing a subset of the multiple titles of media content in a playback device (portions of ordered titles are copied into the receiver)(col. 6, ll. 25-28), wherein the subsets of the multiple titles of media content are automatically selected to update consumed media content according to a user's predetermined specifications (ordered programs overwrite prior segments as playback of the prior segments is completed)(col. 6, ll. 41-44).

13. With regard to claim 41, Walters further discloses that storing a subset of the media content comprises automatically storing a most recent segment (col. 6, ll. 25-28) of a dynamically changing particular audio content (files are audio/video files) (col. 2, ll. 57-58).

14. With regard to claim 42, Walters further discloses that the segment is selectable by the user (users select which programs are ordered)(col. 10, ll. 31-32).

15. With regard to claim 43, Walters further discloses the step of storing a subset of the media content further comprises:

determining a select segment length;

determining a selected particular media content; and

storing a segment of the selected particular media content in the playback device having a length of the selected segment length (content may be stored in various segment lengths, depending on various factors)(col. 6, l.29 co col. 7, l. 6).

16. With regard to claim 44, Walters further discloses that storing a subset of the media content comprises automatically storing a most recent segment from a series of audio content having multiple segments (segments are stored in order)(col. 6, ll. 25-28).

17. With regard to claim 45, Walters further discloses that storing a subset of the media content further comprises:

selecting a segment of the media content;

storing a portion of the media content in a playback device;

determining an amount of the portion of the media content consumed, if any; and

storing a subsequent portion of the media content corresponding to the amount of the portion of media content consumed in the playback device (content is overwritten as it is consumed)(col. 6, ll. 29-44).

18. Claims 46-57 and 70 are rejected under the same rationale as claims 40-45, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

19. With regard to claim 60, Walters further discloses that the library access device is a dedicated audio library access device (receiving unit 220)(col. 8, ll. 11-20).

20. With regard to claims 61 and 62, Walters further discloses that the storage device may be a magnetic disc or optical disc (col. 8, ll. 21-36).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22. Claims 58, 59, 63 and 64 rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al. (US 5,440,334).

23. With regard to claims 58 and 59, while the system disclosed by Walters shows substantial features of the claimed invention (discussed above), it fails to disclose that the library access device is a personal computer or internet terminal.

The Examiner takes Official Notice that personal computers and internet terminals were old and well known in the art at the time the invention was made. One of ordinary skill in the art would have recognized that these types of computers could have been used to access the library and that they would have merely been predictable variations of the receiving unit disclosed by Walters.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to access the library using a personal, computer, internet terminal, or any other type of computing device suitable for accessing the media files.

24. With regard to claims 63 and 64, while the system disclosed by Walters shows substantial features of the claimed invention (discussed above), it fails to disclose that the storage device is a flash memory or that the playback device memory is a flash memory.

The Examiner takes Official Notice that flash memory was old and well known in the art at the time the invention was made. One of ordinary skill in the art would have recognized that flash memory could have been used to store the media files and that

flash memory would have merely been a predictable variation of the memory types disclosed by Walters.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use flash memory as an alternative to the other memory types disclosed by Walters.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Examiner, Art Unit 2448